

REMARKS

Claim 33 is now in the case. Claim 33 recites 2-amino-2-methylpropanol as the alkaline material. Basis is in Claim 49, now cancelled. Claim 33 also specifies that the surfactant is linear and non-aromatic. Basis is at page 7, second paragraph. All other claims have been cancelled without prejudice to Applicants' right to pursue the subject matter of said claims in appropriate divisional or continuation applications. By limiting the present application to Claim 33, it is submitted that patentable subject matter has been defined. In the alternative, it is submitted that prospective issues for Appeal have been narrowed, should an appeal ultimately prove necessary.

Rejections Under 35 USC 103

Claims 31, 33-36, 49 and 51 stand rejected over EPO 503219 ('219) and U.S. 5,538,664 ('664) and U.S. 5, 638,569 ('569) and U.K. 1,357,323 ('323), for reasons of record.

Applicants respectfully traverse all rejections, to the extent they may apply to Claim 33, as now amended.

In order to preserve the record for any prospective appeal, it is noted that previous arguments and citations of relevant case law continue to apply to Claim 33, as now amended. For brevity, not all of such matter will be exhaustively repeated herein.

It is Applicants' position that nothing in the cited documents teaches or suggests selecting and combining certain of the ingredients of the cited documents with certain other ingredients, at the levels prescribed herein, to arrive at the present invention. Attention is again directed to *In re Shuman* 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA, 1966), which states:

It is impermissible to first ascertain factually what appellants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellant's invention from such prior art.

See also *ACS Hospital Systems, Inc. V. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (F. Cir. 1984), cited previously. Also, see the *Mills* case, cited at MPEP 2143.01.

Before turning to the specific grounds of rejection, it is noted that the compositions employed in the process herein are formulated not only to clean hard surfaces, but also to minimize filming /streaking. (See, for example, page 2, penultimate line; page 5, line 5; page 7, line 9.) This desirable result is secured

by proper selection of ingredients for use with a cleaning implement which comprises a superabsorbent material.

The '219 document relates to methods for cleaning hard surfaces, said methods being improved by means of alkanolamines.

It is submitted that, while '219 focuses on cleaning, nothing in '219 addresses the filming/streaking problem associated therewith using the shear thinning polymers in compositions of the present type. Moreover, it is submitted that to suggest the use of such polymers in the compositions of '219 is clearly a hindsight reconstruction of the present invention, since '219 evidences no need for any such polymers to achieve the desired objective of improved cleaning performance.

The '323 document teaches the use of polysaccharide hydrocolloids to facilitate rinsing, enabling the replacement of more expensive foam retardants such as silicones. (Col. 1, lines 20-30.) There is no suggestion to formulate compositions of the present type comprising the recited shear thinning polymer and the 2-amino-2methylpropanol to overcome filming/streaking. In fact, '323 teaches very specifically that its compositions comprise alkaline inorganic salts (Col. 2, line 69) that can be used to provide a pH from 9 to 10.0 (e.g., a mixture of sodium carbonate and sodium bicarbonate, with added sodium tripolyphosphate; see Col. 2, lines 11-14.)

Moreover, as previously discussed, the surfactant levels of the compositions of '323 are well outside the range of the present compositions.

Therefore, it is respectfully submitted that nothing in '323 would suggest substituting the 2-amino-2-methylpropanol for the inorganic alkalinity agents that are specifically disclosed in '323. Moreover, nothing in '323 suggests that the surfactant levels employed therein could be lowered to the range of the instant invention.

The Examiner's comment regarding inherency and the '664 document (O.A., page 5) is noted. For the record, the rejection of 01/12/04 was made under §103. However, the Board has taken a rather strong position that inherency rejections are more properly made under §102. In that regard, attention is directed to the Board's decision in *Ex parte Schricker*, 56 USPQ2d 1723 (BPAI 2000). The Board addresses this specific point at page 1725 [1], noting:

Inherency and obviousness are somewhat like oil and water – they do not mix well.

As stated by the Board at p. 1725, five lines earlier, inherency, "...is really an anticipation rationale...." Accordingly, it is respectfully submitted that §103 is not a proper grounds for any inherency rejection in the instant case.

In any event, The Board also notes at p. 1725 [1]:

However, when an Examiner relies on inherency, it is incumbent on the Examiner to point to the "page and line" of the prior art which justified an inherency theory.

The relevant case law also requires that:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999).

In any event, '664 appears to be silent on the use of polymers of the type employed in the present invention. As shown in the working Examples herein, the streaking grades for compositions (see Example 1 at page 33) without such polymers are inferior to compositions (e.g., Example 2) which do contain such polymers. It is submitted that this desirable result is nowhere suggested in '664.

The '569 document relates to the mop *per se*, and is not particularly instructive with regard to a cleaning compositions of the present type designed for use with the mop.


In short, it is submitted that there is no plausible rationale, absent hindsight, to modify and/or combine the disclosures of the cited documents and arrive at the invention of Claim 33 (amended). In light of the foregoing, withdrawal of the rejections of Claim 33 is requested.

Supplemental IDS

Submitted herewith are USPTO Form SB08 and copies of U.S. 4,725,319 and Canadian application 2,269,730. It is requested that these documents be made of record in the case.

Early and favorable action on Claim 33 is requested.

Respectfully submitted,

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August 25, 2004
Customer No. 27752